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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,512	03/26/2004	James R. Tighe	062891.1231	1184
5073	7590	10/29/2009		
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER MOUTAOUAKIL, MOUNIR	
			ART UNIT 2476	PAPER NUMBER
			NOTIFICATION DATE 10/20/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/810,512

Applicant(s)

TIGHE ET AL.

Examiner

MOUNIR MOUTAOUKIL

Art Unit

2476

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05-29-2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 24-26 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 24-26, and 33-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 35-38 are rejected under 35 U.S.C. 101 because they do not fall within one of the four categories of patentable subject matters of 35 U.S.C 101 (process, machine, manufacturer, or composition of matter). The claims recite "a computer readable medium" which is described in the specification as logic, as best understood, logic is a program, and a program per se is not a patentable subject matter according the interim guidelines.

Claim(s) 1-9 is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. The claims do not qualify as statutory process because they are directed to an abstract idea and recite purely mental steps.

Claim Rejections - 35 USC § 103

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 10-17, 19, 20, 22, 24-26, and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bales et al (US 5,574,724, hereinafter referred to as Bales) in view of Schroderus (US 2003/0223381).

6. Regarding claims 1, 10, 35 and 39. Bales discloses a method for supporting communications comprising: establishing a packet-based audio communication link with a remote device (see fig.1, a packet based audio communication link is established between terminals 106 and 107 through multiple nodes 101-104 using links 111-119); informing a local computing device of the audio communication link (all the network elements within fig.1 are aware of the communication link); receiving a message from the local computing device, the message requesting identification of enhanced media capabilities associated with the remote device (see col.3, lines 32-60. enhanced media capability message is transmitted); receiving a response in the audio communication link from the remote device (see col.3, lines 32-60. enhanced media capability response message is received), the response identifying the enhanced media capabilities associated with the remote device (the response indicated the type of media capability); and forwarding the response to the local computing device (response is forwarded to all the network element within the network figs.1 and 2).

7. Bales discloses all the limitations of the claimed invention with the exception of tunneling request and response messages in the audio link. However, Schroderus, from the same field of endeavor, discloses a method of embedding signaling messages in real time data traffic (see at least paragraph [0011]). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention employ the method of embedding signaling messages into real time traffic, as taught by Schroderus, into the communication system of Bales from the purpose of saving network resources (as suggested by Schroderus).

8. Regarding claims 2, 11, and 36. Bales discloses a communication method, which further comprises determining, at the local computing device, whether the enhanced media capabilities associated with the remote device include a particular enhanced media capability; and communicating enhanced media packets to the remote device in response to determining that the enhanced media capabilities associated with the remote device include the particular enhanced media capability (column 3, lines 35-60. Based on the acknowledgment received, the system determines if the system may or may not support a video communication. If it may, the system initiates the video communication).

9. Regarding claims 3, 12, 24 and 37. Bales discloses a communication method wherein the particular enhanced media capability is a video capability (column 3, lines 35-60. The media capability is a video capability), the enhanced media packets are video packets (figure 1 is a packet switching network), and communicating the enhanced media packets to the remote device comprises tunneling the video packets in the audio communication link to the remote device (See Schroderus: at least paragraph [0011]).

10. Regarding claims 4, 13, 25 and 38. Bales discloses a communication method wherein the particular enhanced media capability is a video capability (column 3, lines 35-60. The media capability is a video capability), the enhanced media packets are video packets (figure 1 is a packet switching network), and communicating the enhanced media packets to the remote device comprises communicating the video

packets in a second communication link to the remote device (column 3, lines 62-67. the audio channel and video channel are different channels).

11. Regarding claims 5, 14 and 26. Bales disclose a communication method that further comprises receiving enhanced media packets from the remote device and automatically displaying (figure 1. 101 is connected to a displaying device 106 to display incoming video from the 104), at the computing device, at least one enhanced media window in response to receiving the enhanced media packets from the remote device (106 is interpreted as a displaying device. Inherently, displaying a video will require the usage of a media window).

12. Regarding claims 6 and 15. Bales discloses a communication method wherein the particular enhanced media capability is an instant-messaging capability (column 3, lines 5-67. The media capability includes audio video capability. Audio video communication between at least two users is considered an instant messaging), the enhanced media packets are instant-messaging packets (fig.1. The system is packet based system), and communicating the enhanced media packets to the remote device comprises tunneling the instant-messaging packets in the audio communication link to the remote device (See Schroderus: at least paragraph [0011]).

13. Regarding claims 7 and 16. Bales discloses a communication method wherein the audio communication link uses Real-time Transport Protocol (RTP) ((See Schroderus: at least paragraph [0053]).

14. Regarding claims 8 and 17. Bales discloses a communication method that further comprises halting communications on the audio communication link; and informing the

local computing device of the halting of communications on of the audio communication link (column 3, lines 5-32. the user establishes the communication link through 101. it is inherent for the user to stop the link established trough 101).

15. Regarding claims 19 and 22. Bales discloses a communication support apparatus. The apparatus comprises an interface operable to couple to a local computing device and a packet network (figure 1, 101 and 106); and a controller coupled to the interface (102), the controller operable to establish a packet-based audio communication link with a remote device (104), to inform the local computing device of the audio communication link (column 3, lines 5-32), to receive a message from the local computing device (column 3, lines 32-60, a messages is transmitted and received), the message requesting identification of enhanced media capabilities associated with the remote device(104 receives a message regarding media capability associated with it), to receive a response in the audio communication link from the remote device column 3, lines 35-60. The system receives an acknowledgment regarding the transmitted request), the response identifying the enhanced media capabilities associated with the remote device (column 3, lines 35-60. An acknowledgment is received regarding the media capability of 103), and to forward the response to the local computing device (101 receives an acknowledgment regarding the transmitted message).

16. Bales discloses all the limitations of the claimed invention with the exception of tunneling request and response messages in the audio link. However, Schroderus, from the same field of endeavor, discloses a method of embedding signaling messages in

real time data traffic (see at least paragraph [0011]). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention employ the method of embedding signaling messages into real time traffic, as taught by Schroderus, into the communication system of Bales from the purpose of saving network resources (as suggested by Schroderus).

17. Regarding claim 20. Bales discloses an apparatus wherein the controller is further operable to tunnel enhanced media packets between the local computing device and the remote device in the audio communication link (See Schroderus: at least paragraph [0011]).

18. Regarding claim 33. Bales discloses a system supporting communications. The system comprises a packet-based telephony device operable to establish an audio communication link with a remote device (fig.1); and a local computing device (104) coupled to the telephony device (103); wherein the telephony device is further operable to receive a message (column 3, lines 32-60. 101 sends media capability request to 103), the message requesting identification of enhanced media capabilities associated with the local computing device (column 3, lines 32-60), to forward the message to the local computing device (figure 2, 203), to receive a response from the local computing device (207, 208, 209), the response identifying the enhanced media capabilities associated with the local computing device (column 3, lines 32-60), and wherein the computing device is further operable to receive the message (203), to generate the response (207), to receive enhanced media packets from the remote device (207), and to automatically display at least one enhanced media window in response to receiving

the enhanced media packets from the remote device (107, associated with 104, is a display device. 107 displays videos received from 101).

19. Bales discloses all the limitations of the claimed invention with the exception of tunneling request and response messages in the audio link. However, Schroderus, from the same field of endeavor, discloses a method of embedding signaling messages in real time data traffic (see at least paragraph [0011]). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention employ the method of embedding signaling messages into real time traffic, as taught by Schroderus, into the communication system of Bales from the purpose of saving network resources (as suggested by Schroderus).

20. Regarding claim 34. Bales discloses a system wherein the enhanced media packets are video packets and the enhanced media window displays video images (column 3, lines 32-60. 101 and 104 exchange video packets, and 107 displays videos received from 101).

21. Claims 9, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bales in view Schroderus and further in view of Bowman-Amuah (US 6,434,568).

22. Bales discloses that halting communications on the audio communication link occurs after receiving an instruction from a user (column 3, lines 5-32. the user establishes the communication link through 101. it is inherent for the user to stop the link established through 101).

23. Bales does not disclose that the instruction selected from a plurality of options comprising hold, transfer, and mute. However, Bowman-Amuah discloses a method

where the user has access to multiple instructions, such as holding, transferring, and muting (see column 61, lines 10-35). Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the method implementing phone features through a computer, as taught by Bowman-Amuah, into the communication terminal of Bales for the purpose of enhancing the capabilities and features of video conferencing or instant messaging.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO_892.

Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

When responding to this office action, applicants are advised to clearly point out the patentable novelty which they think the claims present in view of the state of the art

disclosed by the references cited or the objections made. Applicants must also show how the amendments avoid such references or objections. See 37C.F.R 1.111(c). In addition, applicants are advised to provide the examiner with the line numbers and pages numbers in the application and/or references cited to assist examiner in locating the appropriate paragraphs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOUNIR MOUTAOUAKIL whose telephone number is (571)270-1416. The examiner can normally be reached on Monday-Thursday (1pm-4:30pm) eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2419

/M. M./

Examiner, Art Unit 2476

/Ayaz R. Sheikh/

Supervisory Patent Examiner, Art Unit 2476